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EXAMINER

STEVENS, ROBERT

ART UNIT

PAPER NUMBER

2162

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/942,569

Applicant(s)

BERTHELOT ET AL.

Examiner

Robert Stevens

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a).. In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Office substantially maintains the previous rejections of the claims under 35 USC § 103(a), in light of the amendment.

### ***Response to Arguments***

2. Applicant's arguments filed 7/20/07 have been fully considered but they are not persuasive.

Regarding the previous rejection of the claims under 35 USC §103(a), Applicant argues on page 7 that the Tso reference does not teach determining an order for adapting documents based upon a frequency of access to the documents, and then adapting the documents in the determined order before receiving a request for a second document.

The Office respectfully disagrees, noting that the references as a whole teach the limitations as recited. Tso has been recited for its teachings of the use of frequency access information to calculate document popularity. See Tso col. 7 line 66 – col. 8 line 7. Additionally, both the Mäkipää and Spyglass references teach document adaptation based upon terminal characteristics. See Mäkipää Figure 3 #160 and col. 3 lines 14-20 and col. 6 lines 28-40, teaching the reception of terminal characteristics, col. 6 line 66 – col. 7 line 2, discussing transmission of terminal type from a user. Also see Spyglass page 2 in #4 discussing the conversion of data into the best format for the device.

Regarding the previous rejection of the claims under 35 USC §103(a), Applicant argues on page 7 that the combined teachings of Tso and Mäkipää references is improper because such a combination would not result in the requested document being adapted before the user requests the document.

The Office respectfully disagrees that the combined teachings are improper. It is noted that the claim language recites adapting before a second request. Tso teaches pre-fetching (i.e., storage of documents) based upon popularity, whereas Mäkipää teaches adaptation after the users' first request of the document. It is further noted that the Spyglass reference also teaches checking storage for previously requested converted document. See Spyglass page 5 in the first two paragraphs under "Content Converter and Cache" discussing content conversion and checking the cache for previously requested converted documents, and page 2 in #4 discussing the conversion of data into the best format for the device.

Regarding the previous rejection of the claims under 35 USC §103(a), Applicant argues on pages 7-8 that the Spyglass reference fails to teach adapting documents in which the frequency of access is higher than a threshold.

The Office respectfully disagrees, noting that the references as a whole teach the limitation, as recited. The Spyglass reference was primarily relied upon for its teachings of selecting among previously cached, adapted documents. Tso and Mäkipää were relied upon for their teachings regarding the use of frequency of access probability to determine which documents to prefetch, and the use of user terminal characteristics for document adaptation.

For at least these reasons, the Office asserts the rejections of the claims as set forth below.

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/20/07 has been entered.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 19 and 21-24 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Tso (US Patent No. 6,959,318 filed Mar. 6, 1998 and issued Oct. 25, 2005, hereafter referred to as "Tso") view of Mäkipää et al. (US Patent No. 6,556,217 filed Jun. 1, 2000 and issued Apr. 29, 2003, hereafter referred to as "Mäkipää") and further in view of "Spyglass Prism: Concepts and Applications", Spyglass, Inc., © 1997, pp. i-ii and 1-8, hereafter referred to as "Spyglass".

**Regarding independent claim 19:** Tso discloses: *A server for providing a document via a network*, (See Tso Abstract and Figure 1.) *comprising: determining means for determining an order for adapting documents for outputting the documents according to a frequency of access to the documents;* (See Tso col. 7 lines 50-51, teaching the probability that a page will be accessed, and col. 7 line 65 – col. 8 line 7, discussing the use of “access frequency information” to determine how popular a link is.) *in which the frequency of access is higher than a threshold;* (See Tso col. 7 lines 57-60 in the context of col. 7 lines 45-51 teaching the use of a “cut off” value reflecting link/document popularity.) *and sending means for sending the second document read out by the reading means to the user terminal.* (See Tso Figure 1, shows a full duplex communication path between client 20 and server 35 via the Internet.)

However, Tso does not explicitly disclose the remaining limitations as claimed. Mäkipää, though, discloses *receiving means for receiving a first request for access to a first document from a user terminal* (See Mäkipää Figure 4 #170 and #220 teaching the sending/receiving of content requests via a user device #30.) *acquiring means for acquiring characteristics related to the user terminal contained in said first access request;* (See Mäkipää Figure 3 #160 and Figure 4 #160 in the context of col. 3 lines 14-20 and col. 6 lines 28-40, teaching the reception of terminal characteristics. Also see col. 6 line 66 – col. 7 line 2, discussing transmission of terminal type from a user.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Mäkipää for the benefit of Tso, because to do so would have allowed a

user to view content regardless of the user's terminal screen size, as taught by Mäkipää in the Abstract. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

Additionally, Tso does not explicitly disclose the remaining limitations as claimed. Spyglass, though, discloses *selecting means for selecting documents to be adapted according to the determined order*; (See Spyglass page 3 section entitled "Caches content", discussing faster response time for popular documents.) *adapting means for adapting for output, in accordance with the acquired characteristics related to the user terminal, the selected documents in said determined order before receiving a second request for access to a second document, wherein the adapting means adapts for output documents* (See Spyglass page 5 in the first two paragraphs under "Content Converter and Cache", discussing content conversion and checking the cache for previously requested converted documents.) *receiving means for receiving a second request for access to a document*; (See Spyglass page 4 "HTTP Server Core" section, discussing support for many Web clients. Also see Spyglass page 5 in the first two paragraphs under "Content Converter and Cache", discussing checking the cache for previously requested converted documents.) *reading means for reading out the second document, which has been adapted by the adapting means upon reception of the second request for access to the second document*; (See Spyglass page 5 in the first two paragraphs under "Content Converter and Cache", discussing content conversion and checking the cache for previously requested converted documents.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Spyglass for the benefit of Tso in view of Mäkipää, because to do so would have allowed a system designer to adapt PC-formatted content for display on PDAs and other devices, as taught by Spyglass in the first paragraph under “Introducing Spyglass® Prism” on page 2. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

**Regarding claim 21**, Tso discloses adapting all server documents. (See Tso col. 6 lines 49-60, discussing transcoding all documents by a proxy server.)

**Regarding claim 22**, Tso does not explicitly disclose these limitations. Mäkipää, though, discloses the use of screen size user terminal characteristics. (See Mäkipää Abstract, teaching the use of terminal screen size, and col. 3 lines 14-19, discussing calculation of display space based upon user terminal screen size.)

**Independent claim 23** is directed to a method implemented by the means of the server of independent claim 19. As such, this claim is substantially similar to claim 19 and likewise rejected.



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**Claim 24** is directed to a computer readable storage medium storing a computer program to implement the method of claim 23. As such, this claim is substantially similar to claim 23 and likewise rejected.

***Conclusion***

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Stevens whose telephone number is (571) 272-4102. The examiner can normally be reached on M-F 6:00 - 2:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert Stevens  
Examiner  
Art Unit 2162

October 23, 2007



JOHN BREENE  
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